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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,487	12/29/2000	Ann C. Guilford	2000-0615	4140

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EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/26/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/752,487

Applicant(s)

GUILFORD ET AL.

Examiner

Stephan F Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) 15-35, 50-83 and 86-104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 36-49, 84 and 85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, 36-49, 84-85, drawn to determining the capability of a wireless network, are classified in class 709, subclass 223.
 - II. Claims 15-18, 50-63, 71-72, drawn to determining the capability of a wireless platform (or plan, agreement), are classified in class 709, subclass 220.
 - III. Claims 19-28, 86, drawn to determining a desired wireless network based on a table periodically downloaded, are classified in class 709, subclass 229.
 - IV. Claims 29-35, drawn to determining a desired wireless platform based on a table periodically downloaded, are classified in class 709, subclass 221.
 - V. Claims 64-68, 73-76, drawn to determining a desired wireless network based on network load factors, and quality of service, are classified in class 709, subclass 232.
 - VI. Claims 69-70, 77-83, drawn to determining a desired wireless network based on delay associated with an application, are classified in class 709, subclass 233.
 - VII. Claims 87-92, 97-104, drawn to submitting a request for an offer for processing a wireless request, are classified in class 705, subclass 80.

VIII. Claims 93-96, drawn to submitting a request for an offer for processing a wireless request and choosing a wireless provider based on a subscriber profile, are classified in class 709, subclass 240.

2. The inventions are distinct, each from the other because:

The claims in Group I involve steps to determine wireless network capability, while the claims in Group II specifically involve determining wireless platform capability, while the claims in Group III specifically involve determining wireless network capability based on a table, while the claims in Group VI specifically involve determining wireless platform capability based on a table, while the claims in Group V specifically involve determining a desired wireless network based on network load and QoS, while the claims in Group VI specifically involve determining a desired wireless network based on an application's delay, while the claims in Group VII specifically involve determining a desired wireless network based on requests made for offers to provide a service, and, lastly, while the claims in Group VIII specifically involve determining a desired wireless network based on requests made for offers to provide a service and a subscriber's profile, which are all classified in a different classes.

3. Inventions I-VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and the searches required for Group I is not required for Groups II-VIII, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant's election with traverse of claims 1-14, 57-63, 84-85 by Jacky Spong by telephone on April 23, 2004 is acknowledged.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-14, 36-49, 84-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. with Patent Number 6,591,103.

3. Regarding claim(s) 1, 36, 46, 84-85, Dunn teaches determining a requested service associated with the wireless device as services with parameters such as "AMP, CDMA and TDMA", among others, col. 5, lines 17-23 and a "visitor register", col. 3, line 33. Dunn teaches determining whether one of the wireless networks can provide a requested service, col. 5, lines

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61-64. Dunn teaches if a wireless network can provide the requested service choosing said network, col. 5, lines 64-68 and establishing a parallel session as “continue the call”, col. 5, line 65 and “continue to move”, col. 6, line 5 with a second network.

4. Regarding claim(s) 2, 37, 40-41, Dunn teaches choosing a network based on quality of service, col. 9, lines 46-48. minimum rate as “message rate”, delay as “traffic congestion”, col. 5, line 63.

5. Regarding claim(s) 3, 38, Dunn teaches choosing a network based on cost of service, col. 8, lines 26-29.

6. Regarding claim(s) 4, 39, Dunn teaches choosing a network based on preferred provider agreements, col. 7, lines 28-30 as predetermined “internal” data that reflects a providers agreed upon services.

7. Regarding claim(s) 5, Dunn teaches choosing a network based on network capacity as “loads”, col. 11, lines 3-4.

8. Regarding claim(s) 6-7, 42-43, Dunn teaches choosing a network based on network load, col. 11, lines 3-4 presently serving the wireless device, col. 5-6, lines 64-6 or of another network, col. 6, lines 23-26, col. 7, lines 15, 17, 54-55.

9. Regarding claim(s) 8-9, Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46; col. 10, lines 58-63 as “information” “broadcasted” during “periods”, col. 10, line 40 or downloaded based on a periodic request, col. 7, lines 34-37.

10. Regarding claim(s) 10, Dunn teaches choosing a network based on updated roaming, col. 4, line 54 agreements, col. 7, lines 28-30 as predetermined “internal” data that reflects a providers agreed upon services and is updated as it is broadcast, col. 8, lines 42-46; col. 10, lines

58-63.

11. Regarding claim(s) 11, Dunn teaches table as “information database” downloading as “listens” when the device is initially turned on, col. 6, lines 3-4.

12. Regarding claim(s) 12-13, 44-45, 48-49, Dunn teaches choosing a network when the device is roaming outside, col. 4, line 54; col. 6, lines 20-21, or inside, col. 4, lines 54-55 as “one network coverage pattern” a home service area, col. 5, lines 27-30.

13. Regarding claim(s) 14, Dunn teaches choosing a network based on a table downloaded periodically, col. 8, lines 42-46; col. 10, lines 58-63 as “information” “broadcasted” during “periods”, col. 10, line 40.

14. Regarding claim(s) 47, Dunn teaches choosing a network based on the strongest signal, col. 4, lines 57-58.

Conclusion

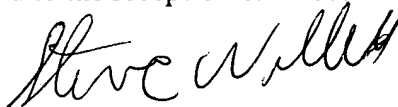
15. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. A close review of the Ramasurbramani reference with Patent Number 6,314,108 and the Shaheen reference with Patent Number 6,374,109 are suggested. The other references cited teach numerous other ways to select wireless network based on a variety of parameters, thus a close review of them is suggested.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

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17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.



Stephan Willett

Patent Examiner

April 28, 2004